

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/023,856
Applicant : BURNETT, JONATHAN R.
Filed : DECEMBER 21, 2001
Title : SYSTEM FOR PROVIDING INFORMATION TO INTENDING CONSUMERS

Art Unit : 2165
Examiner : PARDO, THUY N.

Atty Docket No. : SPFE-0001-UT1

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In conjunction with the Notice of Appeal concurrently filed for the above application involving Claims 1-13, 15, 18, 26-28, 42-44 and 52-53 on appeal (Claims 16-17 have been allowed), Applicant respectfully requests a pre-appeal brief review further to the Official Gazette Notice of July 12, 2005 and the January 10, 2006 Extension thereof that authorize Pre-Appeal Brief Conferences.

I. Basis for Request for Review.

This request is necessitated by: (1) the failure of the Examiner to comply with 37 CFR § 104(d)(2) in providing an Affidavit/Declaration requested in Applicant's August 22, 2005 Amendment (Applicant's Amendment); (2) the failure of the Final Action of November, 2005 (Final Action) to comply with MPEP § 706.02(j) and 37 CFR § 104(c)(2) in fully specifying the basis for rejecting Claims 1-13, 15, 18, 26-28, 42-44 and 52-53 over the combination of U.S. Patent No. 5,895,454 to Harrington *et al.* (Harrington) in view of U.S. Patent No. 6,571,279 to Herz *et al.* (Herz); (3) the failure of the Final Action to comply with MPEP § 706.02(j) in providing a proper "motivation to combine" the references relied on in rejecting Claims 1-13, 15, 18, 26-28, 42-44 and 52-53; and (4) the Final Action's impermissible hindsight reliance on Applicant's disclosure in rejecting Claims 1-13, 15, 18, 26-28, 42-44 and 52-53.

A. Failure to Comply with 37 CFR § 104(d)(2).

In the Office Action of March 21, 2005 (March Office Action), the Examiner made several statements having no basis in the references relied on in rejecting Claims 1-13, 15, 18, 26-28, 42-44 and 52-53. In Applicant's response to the March Office Action, (see Applicant's Amendment,

Section B, pp. 23-24), Applicant properly requested the Examiner to supply an affidavit/declaration under 37 CFR § 1.104(d)(2) in support of those statements. However, the Examiner has failed to provide the requested Affidavit/Declaration, in violation of 37 CFR § 1.104(d)(2). Accordingly, the rejection of Claims 1-13, 15, 18, 26-28, 42-44 and 52-53 is *prima facie* improper and should be withdrawn.

B. Failure to Comply with MPEP § 706.02(j) and 37 CFR § 104(c)(2).

As set forth in MPEP § 706.02(j), “To establish a *prima facie* case of obviousness . . . The prior art reference (or references) when combined must teach or suggest ***all of the claim limitations*** (emphasis added). Furthermore, 37 C.F.R. § 1.104(c)(2) requires that: “The pertinence of each reference, if not apparent, ***must be clearly explained*** and each rejected claim specified.”

The Final Action has failed to identify any portion of Harrington, Herz or any other reference that teaches or suggests the feature of a “search result relating to those of said records including ***products*** meeting said ***product*** identification fields and ***available within a boundary*** determined by [a] distance value of [a] preferred geographical location” as recited in Claims 1-9, 26 and 52. The alleged response to the Applicant’s Amendment in Section 6 of the Final Action also does not address the failure of the combination of Harrington and Herz to teach or suggest the quoted feature of Claims 1-9, 26 and 52. The comment at page 7 of the Final Action that the “Examiner believes that the cited references only need to fulfill one of the limitations followed by ‘***selected from one of . . . etc.***’ is enough to cover that claimed limitation” (emphasis in original) shows that the Examiner only considered the features in the clause of Claim 1 that begins “an input means . . .” and thus failed to identify all of the features recited in the clause of Claim 1 that begins “searching means . . .”, including the quoted features from Claims 1-9, 26 and 52. Applicant’s comments in Sections A(2) of Applicant’s Amendment with respect to the March Office Action’s failure to properly identify where all of the recited features of Claims 1-9, 26 and 52 are taught or suggested also apply to the Final Action.

The Final Action has also failed to show where all of the features of Claims 10-13, 15, 18, 26-28 and 30 are taught or suggested by Harrington and Herz. The only ground set forth in the Final Action for rejecting Claims 10-13, 15, 18, 26-28, and 30 is the following conclusory statement: “As to claims 10-13, 15, 18, 26-28, 30, all limitations of these claims have been addressed in the analysis above, and these claims are rejected on that basis (See Final Action, p. 5). This statement fails to identify any of the features of Claims 10-13, 15, 18, 26-28, and 30 that are taught or suggested by Harrington and Herz, either alone or in combination. Effectively, the Final Action leaves it to Applicant to speculate as to the reasons why Claims 10-13, 15, 18, 26-28, and 30 are rejected. Applicant’s comments in Sections A(3) of Applicant’s Amendment with respect to the failure of the

March Office Action's failure to properly identify where all of the recited features of Claims 10-13, 15, 18, 26-28, and 30 are taught or suggested also apply to the Final Action.

The only grounds set forth in the Final Action for rejecting Claim 42 are the following conclusory statements: "As to claim 42, Harrington and Herz teach the invention substantially as claimed. Harrington further teaches that a wireless communication path for communicating said input query information or said input data between said input means and said searching means via said adjustment means [fig. 2]" (see Final Action, pp. 5-6). These statements fail to identify which elements in Harrington and Herz, either alone or in combination, are considered equivalent to the features of Claim 42. Effectively, the Final Action again leaves it to Applicant to speculate as to what elements of Harrington and Herz are equivalent to the features of Claim 42. The Final Action also states that Fig. 2 shows various elements, but does not identify which elements in Fig. 2 correspond to features of Claim 42. Claims 43 and 44 are dependent on Claim 42, and, therefore, also include the patentable features of Claim 42 that are not identified by the Final Action. Applicant's Amendment also discusses additional reasons why the rejections of Claims 42, 43 and 44 fail to comply with MPEP § 706.02(j) and 37 CFR § 104(c)(2) (See Applicant's Amendment, Sections A(5) and A(6), pp. 19-22).

The only ground set forth in the Final Action for rejecting Claim 53 is the following conclusory statement: "As to claim 53, all limitations of this claim has been addressed in the analysis above, and this claim is rejected on that basis" (See Final Action, p. 6). This statement fails to identify any of the features of Claim 53 that are taught or suggested by Harrington and Herz, either alone or in combination. Effectively, the Final Action once more leaves it to the Applicant to speculate as to the reason why Claim 53 was rejected. Contrary to the requirements of MPEP § 706.02(j) and 37 C.F.R. § 1.104(c)(2), the Final Action makes no attempt to identify any part of any reference that has been relied upon in rejecting Claim 53.

Accordingly, for at least the above reasons, the Final Action fails to comply with MPEP § 706.02(j) and 37 CFR § 1.104(c)(2), and, therefore, the rejection of Claims 1-13, 15, 18, 26-28, 42-44 and 52-53 over the combination of Herz with Harrington is *prima facie* improper and should be withdrawn.

C. Failure to Articulate a Proper Basis for "Motivation to Combine" References.

Nowhere, including in the "Response to Arguments" in Section 5 of the Final Action (see Final Action, pp. 6-7), does the Final Action: (1) provide a proper basis for combining the teachings of the references (Harrington in view of Herz) relied on in rejecting Claims 1-13, 15, 18, 26-28, 42-44 and 52-53; (2) articulate any proper "motivation to combine" these references; or (3) explain where the "motivation to combine" can be found in these references or elsewhere in the art.

The sole alleged basis for combining these references are the following conclusory statements:

However, Harrington does not explicitly teach a distance value and preferred geographical location from which said preferred product is to be sourced. Herz teaches a distance value and a preferred geographical location from which said preferred product is sourced [col.26, lines 16-28; col. 25, lines 26-45].

Therefore, it would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to have modified Harrington's system for identifying appropriated websites which meet the user's specific criteria about the product provided thereof would have incorporated the teachings of Herz for utilizing location-enhanced product finder; the motivation being to expand and enhance the versatility of Harrington's system is to locate the local stores within a radius which most closely match the interest criteria to optimize search operation of finding objects containing the data of interest. (See Final Action, pp. 3-4)

As previously explained in Applicant's Amendment, the alleged basis for combining these references, quoted above, fails to comply with MPEP § 706.02(j), as well as current Federal Circuit case law (see Applicant's Amendment, Section A(1), pp. 13-16). The Final Action's attempt in Section 5 to justify this improper basis for combining these references (see Final Action, pp. 6-7) still fails to provide any proper basis for combining these references that complies with MPEP § 706.02(j), as well as current Federal Circuit case law, such as *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), cited in Applicant's Amendment at Section A(1), pp. 13-16. Nothing alleged in Section 5 of the Final Action explains why a person of ordinary skill in the art reading Harrington would be motivated to consider or read Herz. In fact, beyond acknowledging that "motivation" is a requirement in combining references at page 6, the Final Action never addresses the issue of "motivation to combine" in Section 5.

Because the basis for combining these references fails to comply with MPEP § 706.02(j), as well as current Federal Circuit case law, the rejection of Claims 1-13, 15, 18, 26-28, 42-44 and 52-53 is *prima facie* improper and should be withdrawn.

D. Impermissible Hindsight Reliance on Applicant's Disclosure in Rejecting Claims 1-13, 15, 18, 26-28, 42-44 and 52-53.

The only alleged motivation in the Final Action for combining the cited references, quoted above, appears to be improperly rely on hindsight use of Applicant's own description of Applicant's claimed invention. Effectively, the combination of Herz with Harrington according to the Final Action, presupposes the combination of Herz and Harrington and then provides a hindsight justification, *found nowhere in the references relied on*, for this combination. This hindsight justification is contrary to controlling Federal Circuit precedent in *Cardiac Pacemakers Inc. v. St Jude Medical Inc.*, 72 USPQ2d 1333, 1336 (Fed. Cir 2004) that "Prior knowledge in the field of the invention must be supported by tangible teachings of reference materials, and the suggestion to

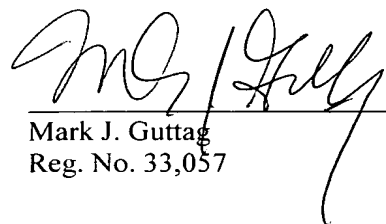
combine references must not be derived by hindsight from knowledge of the invention itself.” The Final Action, including the “Response to Arguments” in Section 5 (see Final Action, pp. 6-7), fails to provide any tangible teachings in the references relied on that properly support the combination of these references.

In addition, the Final Action, in arguing that a person of ordinary skill in the art reading only Harrington would be motivated to look at Herz only cites portions of Herz (see alleged basis for combining Herz with Harrington, quoted above). By only citing portions of Herz, the Final Action, once again, presupposes that the person of ordinary skill in the art has improperly relied on Applicant’s own disclosure to combine Herz with Harrington, rather than looking solely at what Harrington teaches or suggests in the absence of Herz. Because the combination of Herz with Harrington is based on improper hindsight, the rejection of Claims 1-13, 15, 18, 26-28, 42-44 and 52-53 over the combination of Herz with Harrington is *prima facie* improper and should be withdrawn.

II. Relief Requested.

For at least the reasons discussed above, the Final Action: (1) fails to comply with 37 CFR § 104(d)(2) in providing an Affidavit/Declaration requested in Applicant’s Amendment; (2) fails to comply with MPEP § 706.02(j) and 37 CFR § 104(c)(2) in fully specifying the basis for rejecting Claims 1-13, 15, 18, 26-28, 42-44 and 52-53 over the combination of Harrington in view of Herz; (3) fails to comply with MPEP § 706.02(j) in providing a proper “motivation to combine” the references relied on in rejecting Claims 1-13, 15, 18, 26-28, 42-44 and 52-53; and (4) impermissibly relies on Applicant’s own disclosure in rejecting Claims 1-13, 15, 18, 26-28, 42-44 and 52-53. Therefore, Applicant hereby requests that all of the rejections be withdrawn and Claims 1-13, 15, 18, 26-28, 42-44 and 52-53 be allowed.

Respectfully submitted,



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